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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,578	09/23/2003	Jeffrey A. Kusnitz	RSW920030150US1	5640

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IBM CORPORATION  
3039 CORNWALLIS RD.  
DEPT. T81 / B503, PO BOX 12195  
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER
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KNOWLIN, THJUAN P

ART UNIT	PAPER NUMBER
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2614

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/27/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/27/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

RSWIPLAW@us.ibm.com

## Office Action Summary

**Application No.**

10/669,578

**Applicant(s)**

KUSNITZ ET AL.

**Examiner**

Thjuan P. Knowlin

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/28/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 25-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
2. A "carrier wave", as recited in claims 25-32, is a nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture, or composition of matter. A product is a tangible physical article or object, some form of matter, which a signal is not. A signal, a form of energy, does not fall within the definitions for manufacture.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brahm et al (US 7,103,167), in view of Ho et al (US 6,947,730).

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4. In regards to claims 1, 9, 17, and 25, Brahm discloses a telephone, method, and computer storage medium having a first connection to a packet switched network (See Fig. 1 and Internet 106) comprising apparatus for receiving from the packet switched network presence indicators associated with some of the telephone numbers, a memory for storing the presence indicators in association with their corresponding telephone numbers, and apparatus responsive to a selection of an entity by a user for selecting a number for dialing based on the state of the presence indicators associated with the selected entity (See col. 2 lines 56-66 and col. 5 lines 30-41). Although Brahm inherently discloses an apparatus for storing multiple identifications of one or more entities selectable by a user of the telephone that can be called from the telephone, and an apparatus for storing one or more telephone numbers associated with each entity, Ho, more specifically discloses this feature (See Abstract and col. 2 lines 54-67). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to incorporate these features within the system, as a way of increasing answering probability without requiring user searching, thereby effectively reducing the time spent on user searches for other multiple telephone numbers as well as the annoying dialing of multiple telephone numbers.

5. In regards to claims 2, 10, 18, and 26, Brahm discloses the telephone, method, and computer storage medium, having apparatus for placing calls over a circuit-switched telephone network (See Fig. 1 and PSTN 104) and apparatus for placing calls over the packet-switched network (See Fig. 1 and Internet 106) (See col. 7 lines 8-32).

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6. In regards to claims 3, 11, 19, and 27, Brahm discloses all of claims 3, 11, and 19 limitations, however, Brahm does not specifically disclose a base station having connections to the circuit-switched network and to the packet-switched network and a mobile. Brahm discloses that the called party may be a wireless/cellular phone (See col. 2 lines 56-63), therefore, it is inherent that a base station would need to be in connect with the PSTN 104 and the Internet 106, if a wireless/cellular device is used.

7. In regards to claims 4, 12, 20, 28, 33, and 34, Brahm discloses the telephone, method, and computer storage medium, the apparatus for storing the identifications of entities, the telephone numbers associated with the entities and the presence indicators (See col. 2 lines 56-66 and col. 5 lines 30-41), a memory for storing the name of the entities, means allowing a user to select an entity for dialing, and means for transmitting a name of a selected entity to the base station (for example, the name is transmitted to the base station if a wireless/cellular device is used) (See col. 18 lines 18-32).

8. In regards to claims 5, 13, 21, and 29, Brahm discloses the telephone and computer storage medium, further comprising an apparatus for routing a call to the circuit-switched network or to the packet-switched network according to a user preference associated with the selected number (See col. 18 lines 18-38).

9. In regards to claims 6, 14, 22, and 30, Brahm discloses the telephone and computer storage medium, further comprising a memory for storing user routing preferences based on time-of-day (See col. 18 lines 18-25).

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10. In regards to claims 7, 15, 23, and 31, Brahm discloses the telephone and computer storage medium, further comprising a memory for storing user routing preference based on an area code of the selected number (See col. 18 lines 18-27).

11. In regards to claims 8, 16, 24, and 32, Brahm discloses all of claims 8, 16, and 24 limitations, except the telephone and computer storage medium, further comprising an apparatus responsive to an unanswered telephone call for determining if additional numbers are stored for the called entity and re-trying a call to such an additional telephone number. Ho, however, does disclose an apparatus responsive to an unanswered telephone call for determining if additional numbers are stored for the called entity and re-trying a call to such an additional telephone number (See Abstract, col. 2 lines 4-18, and col. 2 lines 54-67).

12. In regards to claim 35, Brahm discloses all of claim 35 limitations, except the system, wherein an identification stored in the handset is a company name. Ho, however, does disclose wherein an identification stored in the handset is a company name (See col. 3 lines 24-34).

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Iwashita et al (US 5,581,595) teach a telephone with auto dialing function. Trandal et al (US Patent Application, Pub. No.: US 2005/0123114 A1) teach methods and systems for telephony call completion. Fish (US Patent Application,

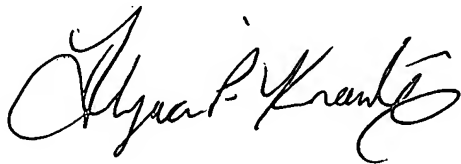
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Pub. No.: US 2004/0243941 A1) teaches presence and geographic location notification based on a setting.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thjuan P. Knowlin whose telephone number is (571) 272-7486. The examiner can normally be reached on Mon-Fri 8:30-5:00pm.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (571) 272-7488. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



THJUAN P. KNOWLIN  
PATENT EXAMINER  
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